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EXAMINER

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3627

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/892,897

Filing Date: June 28, 2001

Appellant(s): KIGHT ET AL.

MAILED

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GROUP 3600

Alfred A. Stadnicki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-22-03.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 3, 6, 7, 8, 9 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51, and 52 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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6,173,272

Thomas et al.

1-9-2001

U.S. Application S/N 09/984,568 for purposes of double patenting

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52, as interpreted by the examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in US Patent number 6,173,272 (Thomas).

Thomas teaches trusted third party data structure for electronic funds transfer and bill presentment. Thomas teaches a bank (or financial service provider) with a network of customers (or payors and payees). Thomas teaches as old and well known in the art for a payor from one bank (financial service provider) to want or have to make a payment to a payee belonging to another bank (or a second financial service provider). As such this payee will belong to a second banking network. Thomas teaches that the automated clearing house network (ACH) is a low-cost electronic payment mechanism to make payments between banking networks (i.e. from one bank to another) (column 7; line 65 – column 8; line 5). Examiner makes special note that this system speaks directly to Applicant's claim language of a payment network including payors and payees. Based on the broadest definition of this limitation a "home banking system with customers" is in fact Applicant's "payment network with a plurality of associated payors and payees".

Thomas further teaches receiving a request to make a payment on behalf of a payer to a payee, transmitting a request to find the banking network payee belongs to, receiving information about the banking network of payee and transmitting payment information (column 4; lines 35-55). Thomas teaches utilizing a trusted third party (TTP, in this situation examiner

interprets the TTP to be synonymous with Applicant's inter-network directory provider) to locate the payee. The TTP uses a unique identifier that identifies the payee when given at least payee's name and address and associates all information about the payee (column 8; lines 47-49 and 56-57). Once association is made the TTP identifies if the transaction will be accepted or not and facilitates the transaction by providing remittance advice. The unique identifier is saved in a database of the TTP and can be used to make other payments to the payee on behalf of the original payer or alternative payers. One of the key objectives of a TTP protocol is to provide secured communications for both payer and payee (column 3; line 65 – column 4; line 5).

Thomas further teaches TTP software available over a network or provided locally. The TTP database houses appropriate deposit and supported transaction types for each of the payees and payers. Also the payment/electronic fund transfer message is sent as a second message set, separate from the original association message or remittance advice.

Thomas does not specifically teach that the payee and the payer are on different payment networks. However, as address previously by Examiner Thomas clearly supports inter-bank transfers via the ACH network in order to provide a low-cost mechanism to efficiently pay individual customers regardless of size (column 7; lines 65 – column 8; line 2). As such it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the system of Thomas to transfer funds from a payor on a first banking network to a payee on a second banking network via the ACH network in order to provide a low-cost mechanism to efficiently pay individual customers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-10, 27, & 31-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53-72 of copending Application No. 09/984,568. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims recite the same method and system for transferring data across multiple networks. Examiner notes that the same system and method is used in both applications with only the intended usage (i.e. sending a bill or transaction request) distinguishing them. As such, the intended use of the product does not make the inventions patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(11) *Response to Argument*

1. LACK OF DUE PROCESS IN THE EXAMINATION.

Examiner notes that Applicant's arguments within this section are drawn towards petitionable issues and therefore are improper for this Appeal Brief. Examiner will limit the responses in this Examiner's Answer strictly to those issues which relate to the merits of the case and are therefore deemed "appealable".

2. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE.

Rejection of Claims 1-52 under 35 USC 103(a)

Beginning with independent claim 1 and specifically Applicant's annotated, limitation-by-limitation analysis of method claim 1 on pages 25 -26, Examiner asserts that an individual bank and its network of customers does correspond to Applicant's payment network having a payment service provider (the bank) and a plurality of associated payers and payees. Thus, any two banks would clearly represent a first payment network and a second payment network.

Examiner further asserts that a first bank receiving a request to make a payment on behalf of one or its customers to a payee not associated with that bank does correspond to Applicant's method step of receiving at a first service provider, a request to make a payment on behalf of a payer to a payee not associated with the first payment network.

Examiner asserts that a first bank transmitting a request to the trusted-third party (hereinafter TTP) in order to identify the RTN of a second bank with which the payee is associated does correspond to Applicant's method step of transmitting a request of the first payment service provider to determine a payment network within the multiple payment networks with which the payee is associated.

At this point Applicant asserts that according to method claim 1, information indicating that the payee is associated with the second payment network is received [implicitly by the first payment service provider]. Examiner disagrees with Applicant's interpretation of the claim limitation. Specifically, Examiner takes exception with Applicant's statement that the first payment service provider implicitly receives the information.

Applicant defends this position by pointing to the last method step of independent claim 1; transmitting a payment instruction from the first payment service provider to the second payment service provider to make the payment to the payee. Applicant asserts that in order for the first service provider to know the identity of the payee's payment service provider, the first provider MUST first receive the information indicating that the payee is associated with the second payment network. However, this is not accurate.

Applicant's use of the transitional phrase "comprising" in the preamble to the claim is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (MPEP 2111.03). As such, Applicant's claim does not exclude the transmitting of a payment instruction from the first payment service provider to the second payment service provider, via a third party intermediate to make the payment to the payee as taught by Thomas et al.

Since Applicant does not expressly indicate in the method step of Claim 1, who receives the information indicating that the payee is associated with the second payment network and since it is not implicit that the first service provider receives this information, Examiner is not required to address this interpretation of the limitation. As such, Examiner reaffirms the position started in the Final Office Action, the TTP receives the information indicating the payee's

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association with the second payment network. In addition, it is inherent and necessarily present to the teaching of Thomas et al. that a payment instruction from the first bank (service provider) to the second bank (service provider) is transmitted through the TTP to make payment to the payee. Examiner knows of no other way to make this payment electronically without a payment instruction.

Examiner further asserts that in view of the above argument and with Applicants use of the non-limiting, transitional phrase “comprising”, Applicant’s argument on page 27 that “in Thomas there is no, and there is no need for, transmission of a payment instruction from the first bank to the second bank to make the payment to the payee is mute.

Examiner also applies the above argument to the independent apparatus claim 27 and notes that if the method for performing a task is rejected, so too is the apparatus for performing that method.

For the reasons above, the Examiner believes that a proper Prima Facie case has been established.

Provisional Rejection of Claims 1, 5-10, 27 and 31-36 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Applicant asserts that the transmission of a payment instruction is materially different from the transmission of an activation instruction. So much so that it would render these two, otherwise identical claims (claim 1 and 53) patentably distinct. Examiner disagrees.

Applicant’s invention is method and apparatus for transferring data between multiple networks; the type of data transferred is merely the intended usage for the method and/or apparatus and therefore holds no patentable weight. Contrary to Applicant’s belief, the differences in the messages have not been ignored; they just have not been considered, as they hold no patentable relevance.

3. THERE IS NO MOTIVATION TO MODIFY THE ART AS PROPOSED BY THE EXAMINER.

Applicant asserts that the Examiner failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art’s own teachings and rendering it unable to meet its primary objective. Examiner once

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again turns to Applicant use of the non-limiting transitional phase “comprising” in the preamble of the independent claims and stands by the rejection as stated in the Final Office Action.

4. THE APPLIED REFERENCE FAILS TO SUGGEST THE CLAIMED INVENTION.

Applicant’s reiterates the argument in relation to independent claims 1 and 27. Examiner once again points to the arguments in section 2. of this Examiner’s Answer.

Applicant asserts that it appears Examiner has not examined dependent claims 3, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 22, 24, 25, 26, 29, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 48, 50, 51 and 52. In response, Examiner points to the Final Office Action.

Specifically, claims 3 and 29 include storing information indicating that the payee is associated with the second payment network, including a unique identifier, receiving a second request at the first service provider to make a payment to payee, retrieving stored information and transmitting a second payment instruction. Once again, Applicant uses the non-limiting, transitional phrase “comprising” in the preamble of the claim and therefore must fall within the scope of the Examiner’s previously stated arguments. In addition, to Applicant’s own admission (page 27 of Appeal Brief) that Thomas et al. teaches in column 4 the TPP determines, based on unique ID, the name and address of the payee and the RTN of the second bank (i.e. information indicating the payment network of the payee based on unique ID).

Claims 6 and 32 include identifying the one or more multiple payment networks as candidate payment networks with which payee may be associated and transmitting information, by the inter-network directory provider, indicating the one or more identified candidate payment networks to first payment service provider and where in the transmitted information indicating the one or more identified candidate networks includes information identifying the second network as a candidate payment network. First, Examiner clearly stipulates in the Final Office Action that the TTP acts as the inter-network directory provider. In addition, Examiner points to column 5; lines 5-15 of Thomas et al. which teaches generating a database at the TTP including name and address information of the payee and a universal unique identifier to identify the payee. Thomas et al. further teaches distributing this database to the home banking system. Examiner asserts that this database, generated by the TTP and distributed to the home banking system (or first payment service provider) clearly corresponds to identifying candidate networks

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associated with payees and communicating that information to the first payment service provider (bank).

Claims 7 and 33 include transmitting a request to the second payment service provider to determine if the payee is associated with the second payment network. Once again Examiner points to Applicants use of the non-limiting transitional phrase “comprising” in the preamble of the claim and makes note that this step can be and is performed by the TTP of Thomas.

Claims 8 and 34 include identifying one candidate payee and at least one other payee associated with the second payment network and determining prior to payment instruction, that the one candidate payee is the payee based upon at least one of 1) information included in the request transmitted to the second payment service provider and 2) received information identifying the one and the at least one other candidate payees. Once again Examiner uses the database of payee names, addresses and unique identifiers generated by the TTP and distributed to the home banking system (Thomas et al. column 5; lines 5-15) and makes note that this database clearly includes multiple (more than one) candidate payees. In addition the system and method of Thomas determines, prior to payment instruction, the correct payee based on a unique identifier provided by the home bank to the TTP, this clearly corresponds to information included in the request transmitted to the second payment service provider.

Claims 9 and 35 include transmitting information identifying the one and at least one other candidate payees to the payer and receiving at the first service provider, the determination that the one candidate is the payee from the payer. Once again, Examiner indicates that the information transmitted to the payer identifying the one and at least one other candidate payee is the database generated by the TTP and distributed to the home banking system (Thomas et al. column 5; lines 5-15). The determination is made by the payer when he inputs the request and selects the payee from database of candidate payees.

Claims 10 and 36 include the first payment service provider determining the payee. Thomas et al. teaches that the home banking system (first payment service provider) produces the universal identifier when supplied with biller's (payee's) name and address (Thomas et al. column 8; lines 55-57) indicating the home banking system (first service provider) can and does make payee determinations.

Claims 11 and 37 include sending requests to a third payment service provider to determine that a candidate payee is not associated with the third payment service provider. Examiner once again relies on the database generated by the TTP and distributed to the home banking system. Candidate payee associated with their service providers within this database. This claim speaks to the development of this database. Thomas et al. teaches in column 16; lines 40-55 that the information for the database is, first supplied from the participating banks and financial institutions. Therefore Thomas et al. clearly teaches, within the development of the candidate database, that all banks (i.e. first – third payment service provides) determine which candidates are associated with their institutions.

Claims 12 and 38 teaches the inter-network directory provider includes information indicating that the second payment service provider requires secured communications and the request transmitted to the second payment service provider is encrypted. Thomas et al. teaching in column 21; lines 43-51, the main features of an encoder supplied to participating banks.

Claims 13 and 39 include a positive declaration from the second service provider that the payee is associated with the second payment network. Examiner once again turns to Thomas et al. column 16; lines 40-55, which teaches the individual banks providing to the TTP information about their payees. Clearly this represents a positive declaration that a payee is associated with their payment network.

Claims 14 and 40 include the inter-network directory provider storing information associated with each of the multiple payment networks and information indicating a network path over which to communicate with a certificate authority. Once again Examiner relies on the Thomas et al.'s teaching of a database generated by the TTP and distributed to the home banking system. Clearly as stated many times above, this database contains all the information needed to transfer funds across multiple networks.

Claims 15 and 41 indicate that the information stored by the inter-network directory provider is accessed and searched by the first payment service provider. Once again Examiner relies on the Thomas et al.'s teaching of a database generated by the TTP and distributed to the home banking system.

Claims 16 and 42 indicate that the information stored by the inter-network directory provider is downloaded and search by the first payment service provider. Once again Examiner

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relies on the Thomas et al.'s teaching of a database generated by the TTP and distributed to the home banking system.

Claims 17 and 43 indicate that information indicating the payee is associated with the second payment network is received from the inter-network directory provider and is a positive determination. This is the argument the examiner has been making through this Examiner's Answer. The TTP indicates that the payee is associated with the second payment network through the database taught in column 5 lines 5-15.

Claims 18 and 44 indicate that a request to determine the payment network of a payee is sent to the second payment network. Once again Examiner turns to column 16; lines 40-55 of Thomas et al. where the TTP requests payee information from the participating banks. Clearly this represents a request sent to a payment service provider to determine whether a payee is associate with the corresponding payment network.

Claims 19 and 45 require that the request to make the payment on behalf of the payer is received from a third payment provider, and the payer and third payment service provider are associated with a third payment network. Examiner asserts that the teachings of Thomas et al. include multiple networks. IN particular, Thomas et al. teaches that the system works best by bringing in as many banks and institutions as possible (column 15; lines 45-50). As such the teachings are not limited to just a first and second network and clearly include a third payment network.

Claims 22 and 48 require that funds are transferred from an account associate with a payer to an account associated with the first service provider, then to an account associated with the second service provider and finally to the payee. Once again, examiner notes that the Applicant's use of the non-limiting, transitional phrase "comprising" allows for a TTP intermediary. As Thomas et al. teaches the use of an automated clearing house (ACH) it is understood that the money is transferred from a payer's account to an account associated with the bank, then to an account associated with the ACH, then to an account associated with the second bank and finally into an account of the payee.

Claims 24, 25, 50 and 51 recite that remittance advice associated with the payment s transmitted to the first payment service provider to the second payment service provider according to a first message set and then from the second payment service provider to the payee

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in a message set different from the first message set. Once again Examiner points to Applicants use of the non-limiting transitional phrase “comprising” in the preamble of the claim and makes note that this step can include the TTP of Thomas. As such Examiner points to Figure 2A and in particular to the box labeled Remittance Info. This illustration shows the remittance information going from the TTP to the Payee, but as explained by the examiner this is acceptable in light of applicant’s preamble.

Claims 26 and 52 require that a determination be made at the second service provider where the payment instruction will be accepted. Clearly this is inherent to the teachings of Thomas et al. There is the only, known way for an electronic payment to be made. An instruction is sent and it is either accepted or not by the receiving party. This feature is inherent to every electronic payment system in the art.

5. THE APPLIED CO-PENDING APPLICATION FAILS TO SUGGEST THE CLAIMED INVENTION

Applicant reiterates the arguments present in Section 2 under the heading ‘Provisional Rejection of Claims 1, 5-10, 27 and 31-36 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting’. Examiner once again asserts that Applicant’s invention is method and apparatus for transferring data between multiple networks; the type of data transferred is merely the intended usage for the method and/or apparatus and therefore holds no patentable weight. Contrary to Applicant’s belief, the differences in the messages have not been ignored; they just have not been considered, as they hold no patentable relevance.

6. THE REJECTION IS BASED EITHER ON AN IMPROPER HINDSIGHT RECONSTRUCTION OF THE INVENTION BASED ON THE APPLICANT’S OWN TEACHINGS OR ON PURE SPECULATION

In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James A. Kramer
Examiner
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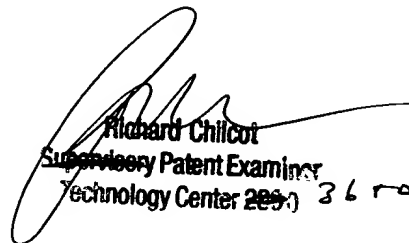
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